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| APPLICATION NO.       | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/808,289            | 03/25/2004  | Akinori Iwase        | 016907-1600         | 5194             |
| 22428                 | 7590        | 06/12/2009           |                     |                  |
| FOLEY AND LARDNER LLP |             |                      | EXAMINER            |                  |
| SUITE 500             |             |                      | HUNTSINGER, PETER K |                  |
| 3000 K STREET NW      |             |                      |                     |                  |
| WASHINGTON, DC 20007  |             |                      | ART UNIT            | PAPER NUMBER     |
|                       |             |                      | 2625                |                  |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |  |                                     |
|------------------------------|--|-------------------------------------|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/808,289   | <b>Applicant(s)</b><br>IWASE ET AL. |
|                              | <b>Examiner</b><br>Peter K. Huntsinger | <b>Art Unit</b><br>2625             |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 March 2009.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 25,27-29,37,39,40,42,43 and 48-50 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 25,27-29,37,39,40,42,43 and 48-50 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed 3/16/09 have been fully considered but they are not persuasive.

The applicant argues on pages 6 and 7 of the response in essence that: Yoneda '157 and Wood '127 do not disclose receiving a trial printing command and image data from an external PC.

a. Yoneda '157 discloses receiving a trial printing command (col. 18, lines 23-24, user selects partial printing by using confirmation display portion item 132), but does not disclose expressly receiving the command and image data from an external PC. Wood '127 discloses receiving a printing command and image data from an external PC (col. 2, lines 5-17, user interface allows the computer to communicate print job to copier). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant argues on pages 6 and 7 of the response in essence that: Yoneda '157 does not disclose deleting the printing job and image data after the image is formed.

b. It is inherent that the printing system of Yoneda '157 deletes image data after printing. The image data storage must be cleared of unnecessary data to provide storage space for future print data or the printing system would be unable to print any more documents.

The applicant argues on page 7 of the response in essence that:

Yoneda '157 and Wood '127 do not disclose the advantages of the invention.

c. In response to applicant's argument that Yoneda '157 and Wood '127 do not disclose the advantages of claim 25, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 25, 27-29, 37, 39, 40, 42, 43 and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No. Yoneda 5,222,157 in view of Wood Patent No. 6,453,127.

Referring to **claim 25**, Yoneda '157 discloses an image forming system comprising:

receiving a printing job including a trial printing command and an image data (col. 18, lines 23-24, user selects partial printing by using confirmation display portion item 132);

a control panel (control display panel 117, col. 14, lines 63-66) including a first touch screen menu including a trial printing button (partial print, see Fig. 12, col. 17-18, lines 64-68, 1-7) configured to, when user selected, initiate a trial preceding print of a page of image data (col. 18, lines 23-24, user selects partial printing by using confirmation display portion item 132) and a printing button configured to, when selected by a user, initiate printing of all pages of the image data in response to the selection of the printing button (All print, see Fig. 12, col. 17, lines 63-66);

a printer that performs the trial preceding print by printing the image data in response to the trial printing command received and the selection of the trial printing button (col. 17-18, lines 64-68, 1-7, can be selected to print all or partial);

a controller (CPU 10 of Fig. 1, col. 4, lines 12-20) that sets a desired specification according to operation of the control panel after the printer performs the trial preceding print (Fig. 11 shows printing options), and deletes the image data and the printing job after the printing of all pages (it is inherent that the printing system of Yoneda '157 must clear unnecessary data to provide storage space for future print data);

wherein the printer is configured to print all pages of the image data according to the desired specification set by the controller (the document can be printed and then printed again).

Yoneda '157 does not disclose expressly printing in response to a command from a PC and setting print density information.

Wood '127 discloses a receiving section that receives a printing job including a printing command and an image data from an external PC (col. 2, lines 5-17, user interface allows the computer to communicate print job to copier);

a printer that performs printing in response to a command received from an external PC via communication lines, and performs the printing of all pages of the image data being received from the PC (col. 2, lines 5-17, user interface allows the computer to communicate print job to copier); and

setting print density information (col. 3, lines 54-65, print job options include darken-lighten image quality).

At the time of the invention, it would have obvious to a person of ordinary skill in the art for a printer to receive image data from a PC and to allow the user to set print density information. The motivation for doing so would have been to enable printing computer based data and to allow the user to print darker or lighter documents. Therefore, it would have been obvious to combine Wood '127 with Yoneda '157 to obtain the invention as specified in claim 25.

Referring to **claim 27**, Yoneda '157 discloses a scanner for scanning at least one original page to obtain a digital image thereof as the page of image data (scanner interface 40 of Fig. 3), and a memory for storing image data (page memory, see Fig. 6).

Referring to **claim 28**, Yoneda '157 discloses wherein the control panel further includes a second touch screen menu displayed after the printer performs the trial preceding print, the second touch screen menu including a print button configured to, when user selected, initiated printing the page of image data according to the desired specification set by the controller (see Fig. 11, the document can be printed and then printed again).

Referring to **claim 29**, Yoneda '157 discloses an image forming system comprising a printer, but does not disclose expressly a plurality of data processors that transfer images to the printer.

Wood '127 discloses a plurality of data processors communicatively coupled to the image forming apparatus, and configured to send image data to the image forming apparatus (col. 2, lines 61-65, computers 30 and 30' allow a user to transmit print jobs to the respective copier/printer).

At the time of the invention, it would have obvious to a person of ordinary skill in the art for multiple computers to be connected to a printer.

The motivation for doing so would have been to allow sharing one printer with multiple users. Therefore, it would have been obvious to combine Wood '127 with Yoneda '157 as in claim 29.

Referring to **claim 37**, see the rejection regarding claim 25 above.

Referring to **claim 39**, see the rejection regarding claim 27 above.

Referring to **claim 40**, see the rejection regarding claim 28 above.

Referring to **claim 42**, Yoneda '157 discloses a process for performing a trial preceding print in an image forming apparatus, comprising:

receiving an instruction in response to a selection of a touch screen trial printing button on a control panel (control display panel 117, col. 14, lines 63-66) to initiate a trial preceding print of image data (partial print, see Fig. 12, col. 17-18, lines 64-68, 1-7);

receiving an instruction in response to a selection of a touch screen printing button on the control panel to initiate printing of all pages (All print, see Fig. 12, col. 17, lines 63-66);

performing the trial preceding print with a printer by printing the image data in response to the selection of the trial printing (col. 17-18, lines 64-68, 1-7, can be selected to print all or partial);

performing the printing of all pages of the image data in response to the selection of the printing button (All print, see Fig. 12, col. 17, lines 63-66);

displaying a plurality of print value buttons on the control panel after the printer performs the trial preceding print, the plurality of print value buttons configured to be user selectable to permit the user to change a specification for printing from a specification used for the trial preceding print (Fig. 11 shows printing options), and deleting the image data after the printing of all pages (inherent that the printing system

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of Yoneda '157 must clear unnecessary data to provide storage space for future print data), and

printing the image data with the printer according to the changed specification if the user changes the specification from the specification used for the trial preceding print (the document can be printed and then printed again).

Yoneda '157 does not disclose expressly printing in response to a command from a PC and setting print density information.

Wood '127 discloses receiving a command and image data from an external PC using a communication line (col. 2, lines 5-17, user interface allows the computer to communicate print job to copier); and

permitting a user to change a specification including print density information for printing (col. 3, lines 54-65, print job options include darken-lighten image quality).

At the time of the invention, it would have obvious to a person of ordinary skill in the art for a printer to receive image data from a PC and to allow the user to set print density information. The motivation for doing so would have been to enable printing computer based data and to allow the user to print darker or lighter documents. Therefore, it would have been obvious to combine Wood '127 with Yoneda '157 to obtain the invention as specified in claim 42.

Referring to **claim 43**, Yoneda '157 discloses selecting a touch screen print button on the control panel to, if the user does not change the specification for printing,

initiate printing of the image data according to the specification used for the trial preceding print (see Fig. 11, the document can be printed and then printed again).

Referring to **claim 48**, Yoneda '157 discloses the control panel comprising a touch screen menu.

Naito '107 discloses a density button configured to, when user selected, set the print density information (print density designation keys 44c of Fig. 9, col. 6, lines 9-18).

Referring to **claim 49**, see the rejection of claim 48 above.

Referring to **claim 50**, see the rejection of claim 48 above.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter K. Huntsinger/  
Examiner, Art Unit 2625

/David K Moore/  
Supervisory Patent Examiner, Art Unit 2625